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| 10/527,903 | 03/14/2005 | Fabio Perini | 71699 | 9066 |
| 23872 7590 05/09/2008 MCGLEW & TUTTLE, PC P.O. BOX 9227 SCARBOROUGH STATION SCARBOROUGH, NY 10510-9227 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/527,903
Filing Date: March 14, 2005
Appellant(s): PERINI, FABIO

John James McGlew (31,903)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03/31/2008 appealing from the Office action mailed 01/04/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|------------|--------------|---------|
| DE10043989 | Eisenschmidt | 03/2001 |
| JP10249926 | Kubo et al | 09-1998 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 6-10, 13, 16-17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eisenschmidt (DE10043989) in view of Kubo et al (JP10249916).

Eisenschmidt discloses a pair of embossing rolls for making tissue articles. As shown in the figures, the rolls 1 and 2 comprise shafts 5 and 5" and engravings 3 and 6 which are used to emboss layers of tissue articles 9. These engravings have a helicoidal configuration with a preset pitch and direction in the manner claimed by the applicant.

However, Eisenschmidt does not disclose the elastic surface as claimed by the applicant. Regarding this difference, the applicant is directed to the reference of Kubo.

Kubo discloses a roller construction for pressing sheet materials. As shown in the figure, the roll 1 comprises shaft core 2, rubber layer 3, nickel tube 4a with hard chrome plated film 4b.

Such a construction improves deflectability, which imparts better embossing of the materials (see abstract). Therefore, it would have been obvious to one having ordinary skill in the art to employ an elastic material with a hard outer surface, as taught by Kubo, in the device of Eisenschmidt in order to provide the predictable result of improving the deflectability to impart better embossing of the materials.

Claims 5, 11-12, 14-15 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eisenschmidt in view of Kubo et al as described above in further view of McNeil et al (US Patent 6,030,690)

McNeil discloses an embossing apparatus comprising embossing rolls 30 and 32, which are preferably made of steel. See col. 8, lines 17-21. Such a material *inherently* has desirable physical and mechanical properties such as high strength and durability. For these reasons, it would have been obvious to one having ordinary skill in the art to employ steel in the outer surface of the embossing rolls of Eisenschmidt in view of Kubo as described above.

Regarding claims 12, 15 and 19, it is the examiner's position that adhesives are well known in the art for securely bonding or joining various materials together. Therefore it would have been obvious to one having ordinary skill in the art to employ an adhesive to connect the elastic material and the hard outer surface in order to provide the predictable result of more securely joining or bonding the materials together.

(10) Response to Argument

Applicant's arguments filed 03/31/2008 have been fully considered but they are not persuasive.

Applicant argues Kubo et al. discloses that a roller having a resilient surface is crucial, but fails to suggest a hard outer surface supported by an elastic surface as claimed. The examiner does not agree. The abstract of Kubo et al specifically describes material 4b as a hard chrome plated film. Therefore applicant's argument is believed to be incorrect in this instance.

Applicant argues Kubo et al. fails to address the problem of compressing paper webs to form a single continuous paper web without deforming or adversely altering the web. However, it is noted that the features upon which applicant relies (i.e., without deforming or adversely altering the web) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as stated above, The construction disclosed by Kubo et al improves deflectability, which imparts better

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embossing of the materials (see abstract). Therefore, it would have been obvious to one having ordinary skill in the art to employ an elastic material with a hard outer surface, as taught by Kubo, in the device of Eisenschmidt in order to provide the predictable result of improving the deflectability to impart better embossing of the materials.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/James Sells/

Primary Examiner, Art Unit 1791

Conferees:

/Yogendra N Gupta/

Supervisory Patent Examiner, Art Unit 1791

/Christopher A. Fiorilla/

Chris Fiorilla

TQAS, TC 1700